

REMARKS

Upon entry of the present amendment, no claims will have been amended, modified or newly submitted. Rather, Applicant respectfully requests reconsideration of the outstanding rejections together with an indication of the allowability of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant notes with appreciation the Examiner's consideration of the documents cited in the Information Disclosure Statement filed on September 1, 2004 by the return of the signed and initialed PTO-1449 Form attached to the outstanding Official Action.

In the outstanding Official Action, the Examiner rejected claims 19-24, 27-33 and 37-60 under 35 U.S.C. § 103(a) as being unpatentable over SMITH et al. (U.S. Patent No. 6,385,655) in view of SAITO et al. (EP 0 835 011).

In setting out the rejection, the Examiner essentially asserted that SMITH et al. shows the communication apparatus as recited but does not disclose a control panel configured to at least enter a destination address and the performing of an e-mail transmission to a destination in response to an input from the control panel. The Examiner relied on SAITO et al. for these features and concluded that SMITH et al. and SAITO et al. are combinable because they are from the same field of endeavor. The Examiner identified the field of endeavor as systems that transmit electronic mail and create a file in an HTML format. Applicant respectfully traverses the above rejection and submits that it is inappropriate at least for the reasons set forth hereinbelow.

Initially, Applicant wishes to make of record a telephone interview conducted between Applicant's undersigned representative and Examiner Pokrzywa in charge of the present application. This interview was conducted by telephone on December 9, 2004. The Examiner is respectfully thanked for his cooperation in scheduling and conducting the above-noted interview as well as for his open minded approach to the outstanding rejection and to the features of Applicant's invention and claims, as exhibited during the above-noted interview.

During the above-noted interview, Applicant's representative pointed out reasons for the patentability of the claims in the present application with respect to the combination of SMITH et al. and SAITO et al. asserted by the Examiner in the outstanding Official Action including that even if combined as proposed, the combination of SAITO et al. and SMITH et al. would not result in the recited combinations. These reasons will be set forth hereinbelow to complete the record in the present application. At the conclusion of the interview, the Examiner indicated that he now understood the distinctions being made between the claims of the present application and the disclosures of the references cited by the Examiner and that he accepted Applicant's arguments with respect to these references. The Examiner also indicated that he would reconsider the rejection and would, of course, perform an appropriate update search in view of his understanding of the present invention.

Again, Applicant respectfully thanks the Examiner for his consideration of his arguments and for his cooperation during the above-noted interview which hopefully will expedite the allowance of the present application.

As previously noted, Applicant's invention is directed to a communication apparatus that is connected to a terminal apparatus via a network. The communication apparatus includes a control panel configured to at least enter a destination address and an e-mail transmitter that performs an e-mail transmission to a destination in response to an input from the control panel. Applicant's invention further includes a file generator that generates a communication result file that includes a result of the e-mail transmission communication performed by the e-mail transmitter and a memory that stores the communication result file as an HTML file. Applicant's invention further includes a communicator that transmits the communication result file to the terminal apparatus when a request for the communication result file is received from the terminal apparatus, the communication result file being displayed at the terminal apparatus.

In other words, Applicant's invention relates to the interactions of three devices: a destination, a terminal apparatus and the communication apparatus that is the subject of Applicant's claims. According to Applicant's invention, e-mail transmission is performed to a destination by the communication apparatus. On the other hand, the communication result file is transmitted to the terminal apparatus by the communication apparatus, in response to a request for the communication result file from the terminal apparatus.

While Applicant's invention has been described with reference to the combination of features recited in Applicant's claim 19, generally similar features are recited in the other independent claims and Applicant's remarks apply also to the other independent claims, taking of course into consideration the different language used therein.

In setting forth the rejection, the Examiner asserted that the communication apparatus recited in Applicant's claims corresponds to the server 22 of SMITH et al. Applicant respectfully traverses. Applicant respectfully submits that, as admitted by the Examiner, the server 22 does not include a control panel and there is no reason why one would modify the server by including therein a control panel to enter a destination address. The server 22 of SMITH et al. serves to forward an e-mail received from the computer 14, which the Examiner identifies as the terminal apparatus, to a receiving apparatus. In order to accomplish this stated purpose of SMITH et al., there is no need for a control panel on the server, since the destination is input by the computer 14.

In setting forth the rejection, the Examiner asserts that the communication result file is transmitted to the terminal apparatus. However, this is incorrect. As is clearly set forth in the paragraph bridging columns 5 and 6 of SMITH et al., the notification message is sent to the recipient (not to the terminal apparatus) and in response, the recipient downloads the stored document from the server.

As noted above, Applicant's invention relates to a document that is sent to a destination but the communication result file is sent to the terminal apparatus. This feature is also not disclosed by SMITH et al.

In setting forth the rejection, the Examiner further asserts that since SAITO et al. discloses a communication apparatus including a control panel, it would be obvious to include the teachings of a control panel in the server of SMITH et al. since, according to the Examiner, "SAITO et al.'s facsimile apparatus (netfax 1) has an internal server mechanism, thus can be considered a server". Applicant respectfully traverses and submits that the Examiner's combination is inappropriate.

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Initially, Applicant notes that the netfax 1 of SAITO et al. corresponds to the sending terminal and thus according to the Examiner's interpretation of SMITH et al., the netfax 1 corresponds to the sender computer 14. Thus, all the Examiner has achieved by his combination is that the sending computer can have a control panel. However, the sending computer 14 of SMITH et al. already has a control panel (i.e., keyboard). The Examiner has not provided any evidence or disclosure in SAITO et al. of a server that is neither the sender nor the recipient (as is the case with the server 22 of SMITH et al.) that is provided with a control panel configured to operate and to provide the features recited in Applicant's claim 19.

Moreover, the HTML document of SAITO et al. is not a communication result file as that term is recited in Applicant's claim. Rather, the HTML file of SAITO et al. includes the image data to be sent from the netfax to the reception terminal 3. In this regard, the Examiner's attention is respectfully directed to column 7, lines 25-33 of SAITO et al. Moreover, and directly contrary to the Examiner's assertion that SAITO et al.'s facsimile apparatus is a server, at column 3, line 44, SAITO et al. explicitly discloses that the image data to be transmitted is stored in a server located on the communication network 2. Thus, clearly the unidentified server on the network 2 corresponds to SMITH et al.'s server 22 and yet again it is clear that the Examiner has not provided any teaching whatsoever for a server to include a control panel that inputs a destination address and that transmits e-mail to the destination in response to an input from the control panel.

Moreover, while the Examiner asserts that SMITH et al. stores a communication result file as an HTML file, Applicant submits that the Examiner is incorrect. The

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reference to the HTML file in SMITH et al. relates to the documents being transmitted rather than a communication result file as defined in Applicant's invention. In this regard, the Examiner's attention is directed to column 5, lines 39-46. Similarly, as noted above, the HTML file of SAITO et al. also represents the compressed image data rather than data corresponding to a communication result file. In this regard, the Examiner's attention is directed to SAITO et al., column 6, lines 34-37 as well as the previously cited column 7, lines 25-33.

Accordingly, for this yet additional reason, Applicant respectfully submits that the combination of SMITH et al. and SAITO et al., even if proper, would not result in the combination of features recited in Applicant's claims.

Moreover, Applicant respectfully submits that the Examiner has not set forth a proper motivation for a combination of SMITH et al. and SAITO et al. In this regard, merely because two references are from a same field of endeavor does not mean that they are combinable. In this regard, 35 U.S.C. § 103 requires a motivation stemming from the prior art for the obviousness of the proposed combination. The Examiner has set forth no such motivation and for this additional reason, the Examiner's rejection is inappropriate.

Regarding the Examiner's assertion that providing a control panel to the server would make the server of SMITH et al. more user friendly, Applicant respectfully submits that there is no such teaching in either of the references cited by the Examiner.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all the claims

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pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has not amended the claims but has traversed the Examiner's rejection. In particular, the Examiner has pointed out the numerous shortcomings and deficiencies of the references relied upon by the Examiner, both individually as well as in the proposed combination. Applicant has compared the explicit recitations of Applicant's claims with the disclosures of the references and has pointed out the deficiencies thereof.

Applicant has further made of record a telephone interview conducted between Applicant's representative and the Examiner during which the Examiner essentially agreed with Applicant's arguments regarding patentability with respect to the applied references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication to such effect in due course.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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